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MAR 16 2004

In re Application of
Thomas L. Bybee et al.
Application No. 10/627,415
Filed: July 25, 2003
Attorney Docket No.

OFFICE OF PETITIONS

ON PETITION

This is in response to the petition under 37 CFR 1.47(a), filed December 22, 2003.

The petition is dismissed.

Rule 47 applicant is given TWO MONTHS from the mailing date of this decision to reply, correcting the below-noted deficiencies. Any reply should be entitled "Request for Reconsideration of Petition Under 37 CFR 1.47(a)," and should only address the deficiencies noted below, except that the reply may include an oath or declaration executed by the non-signing inventor. **FAILURE TO RESPOND WILL RESULT IN ABANDONMENT OF THE APPLICATION.** Any extensions of time will be governed by 37 CFR 1.136(a).

A grantable petition under 37 CFR 1.47(a) requires: (1) proof that the non-signing inventor cannot be reached or refuses to sign the oath or declaration after having been presented with the application papers (specification, claims and drawings); (2) an acceptable oath or declaration in compliance with 35 U.S.C. §§ 115 and 116; (3) the petition fee; and (4) a statement of the last known address of the non-signing inventor. Applicant lacks items (1) set forth above.

As to item (1), the petitioner states "On October 21, 2003 a letter was sent to Tom Bybee, Dave Murphy, Steve Wright and Sheri Kime, four of the joint inventors in the above-identified patent application, requesting that they each sign a declaration for the application, and an assignment of the application."

The letters mailed on October 21, 2003 indicated that a Declaration for the application and an Assignment of the application were mailed to the non-signing inventors (Tom Bybee, Dave Murphy, Steve Wright and Sheri Kime) for signature. However, it is not merely enough that the non-signing inventors' signatures on the declaration were requested. Petitioner must demonstrate that the non-signing inventors were presented with a copy of the application papers (specification, claims and drawings). Otherwise, the non-signing inventors could not attest that they have "reviewed and understand the application papers" and therefore could not sign the declarations which were requested for each inventor to sign. Accordingly, under Rule 47, the

applicant failed to show or provide proof that the non-signing inventors have refused to sign the declaration. Did the non-signing inventors receive the application papers? See Manual of Patent Examining Procedure, Section 409.03(d). Petitioner should show that copies of the application papers were presented to the non-signing inventors, but the non-signing inventors did not respond to the petitioner's request that they sign the oath/declaration in order to show that the inventors have refused to join in the application.

Further correspondence with respect to this matter should be addressed as follows:

By mail: Mail Stop PETITION
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Telephone inquiries related to this decision should be directed to Irvin Dingle at (703) 306-5684.

Frances Hicks
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